

REMARKS

I. PRELIMINARY REMARKS

A minor modification has been made to the specification. Claims 1, 9, 16, 19, 22, 30 and 31 have been amended. No claims have been canceled. Claims 32-34 have been added. Claims 1, 3-5, 7, 9, 11-13, 16-20, 22-26 and 30-34 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

II. THE AMENDMENT TO THE SPECIFICATION

A patent application may be amended so as to recite subject matter that was inherently disclosed in the application as filed. More specifically, the Manual of Patent Examining Procedure ("MPEP") states:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, ***even though it says nothing explicit*** concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'"

[MPEP § 2163.07(a), citations omitted, emphasis added.] In the present application, the specification has been amended so as to recite the functionality of the touch pad 128, i.e. that "a user can move a pointer (or cursor) on the display 112 by moving a finger or other object along the touch pad 128." Applicant respectfully submits that the amendment satisfies the standard set forth in the MPEP because, as illustrated below, one of skill in the art would understand such functionality was necessarily present.

The present application, as filed, indicated that the exemplary portable computer 100 illustrated therein "is, with respect to many of the structural and operating components, substantially similar to conventional portable computers such

as the Hewlett-Packard Omnibook 6000 notebook PC.” [Page 4, lines 26-29.] Attached hereto as Exhibit 1 are pages 26 and 27 of the Omnibook 6000 Reference Guide. The Omnibook 6000 Reference Guide clearly indicates that a touch pad is “a touch-sensitive pointing device” that is used to move a “pointer.” The present application, as filed, also indicated that the exemplary portable computer 100 may include the Microsoft® Windows operating system. [Page 5, lines 18-19.] Applicant respectfully submits that those of ordinary skill in the computer art understand that the Microsoft® Windows operating system employs a pointer that may be moved around a display to, *inter alia*, identify icons that are to be clicked (or double clicked) with a click button. This pointer functionality is also explained on page 26 of the Omnibook 6000 Reference Guide.

Turning to the general knowledge of those of skill in the art, attached hereto as Exhibit 2 is the definition of the word “touchpad” from Webopedia™, which is an “online dictionary for words, phrases and abbreviations that are related to computer and Internet technology.” The Webopedia™ online dictionary defines “**touchpad**” as follows:

A small, touch-sensitive pad **used as a pointing device** on some portable computers. By moving a finger or other object along the pad, you can **move the pointer** on the display screen.

[Emphasis added.] Similarly, as shown in Exhibit 3, the TechTarget WhatIs.com listing of IT terms defines “**touchpad**” as follows:

A touch pad is a **device for pointing** (controlling input positioning) on a computer display screen. It is an alternative to the mouse. Originally incorporated in laptop computers, touch pads are also being made for use with desktop computers. A touch pad works by sensing the user's finger movement and downward pressure.

[Emphasis added.]

As illustrated above, one of skill in the art who had reviewed the present application would readily understand that the functional explanation of the word “touchpad” added to the specification by the present amendment is the inherent functionality of a “touch pad.” Such an amendment is not, therefore, new matter and should be entered.

III. REJECTIONS UNDER 35 U.S.C. § 103

A. The Rejections

Claims 1, 3-5, 7, 9, 11-13, 16-20 and 22-26 have been rejected under 35 U.S.C. § 103 as being unpatentable over combined teachings of the Brownlee patent (U.S. Patent No. 6,282,303) and the Holehan patent (U.S. Patent No. 6,043,809). Claims 30 and 31 have been rejected under 35 U.S.C. § 103 as being unpatentable over combined teachings of the Brownlee patent, the Holehan patent and the Liao application (U.S. Pub. App. No. 2001/0048429). The rejections under 35 U.S.C. § 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. Discussion

Independent claims 1, 9 and 16 call for respective combinations of elements including, *inter alia*, “an at least partially transparent roller” and “**a touch pad**, adjacent to the roller, **adapted to move a pointer** on the display.” The combinations defined by claims 3-5, 7 and 30 include the elements recited in claim 1, the combinations defined by claims 11-13 and 31 include the elements recited in claim 9, and the combinations defined by claims 17-19 and 22-26 include the elements recited in claim 16. The cited references fail to teach or suggest such combinations.

For example, although the Brownlee patent discloses a fingerprint scanning/cursor control device including a transparent roller on a keyboard, the Brownlee patent does not teach or suggest placing the transparent roller adjacent to a touch pad that is adapted to move a pointer on a display. The Office Action seeks to remedy the deficiencies in the Brownlee patent with the teachings for the Holehan patent. Applicant respectfully submits that it fails to do so and that the rejection under 35 U.S.C. § 103 should be withdrawn because the Holehan patent does not disclose a “touch pad” and, accordingly, could not suggest adding a “touch pad” to the Brownlee keyboard.

The Holehan patent is directed to a computer keyboard with **“scroll bar”** sensors that control the operation of horizontal and vertical scroll bars. Referring to Figure 2, the Holehan patent discloses a computer system 200 running a computer program 212 which is displayed on a monitor 210. The program 212 includes up/down and left/right scroll bars 214 and 216. As noted in the Holehan patent, such scroll bars are “for scrolling up or down through a document” and “for scrolling to the right or to the left in a document.” [Column 3, lines 29-33.] The computer system 200 also includes a keyboard 230 with a plurality of scroll bar sensors 232, 234, 236, 239 and 241. The computer user can scroll up/down and left/right within a document by touching one of the scroll bar sensors in the appropriate place. [Column 4, lines 20-40; and column 5, lines 28-33.] For example, the computer system will display the left portion of the document if the user touches the left side of the scroll bar sensor 236.

Although the Holehan scroll bar sensors employ some of the same sensor technology employed in touch pads, as is discussed in column 4, lines 1-19, applicant respectfully submits that there is no reasonable interpretation of the term “touch pad ... adapted to move a pointer on the display” that would read on the Holehan scroll bar sensors.

The term **“touch pad”** is used in the computer art generally, and the present application in particular, to describe a device that **used to move a “pointer”** around a display, as is discussed in detail in Section II above. With respect to the meaning of the term “pointer,” and referring to Exhibit 4, the WebopediaTM online dictionary defines **“pointer”** as follows:



Grabber pointer



I-beam pointer



Selection pointer

[A] small **arrow or other symbol** on the display screen that moves as you move the mouse. You can **select commands and options by positioning the tip of the arrow over the desired choice and clicking** a mouse button.

[Emphasis added.]

The Holehan scroll bar sensors, on the other hand, are used to control the position of **“scroll bars.”** One of ordinary skill in the art would certainly understand that a “scroll bar” is not a “pointer.” To the contrary, a “scroll bar” is known in the

computer art as a device that controls which part of a document appears in a window frame. The Holehan patent, for example, describes "scroll bars" and "scrolling" as follows:

Because of the limited size of a computer display, a computer operator typically can not view on entire document or spreadsheet on the display at one time. Rather, the operator must "scroll" through the document to view various portions of the document. Scrolling usually includes the ability to scroll up and down through a document, as well as left and right. Many software programs include one or more **scroll bars to allow the computer operator to view various portions of the data not currently view able on the display.**

[Column 1, lines 28-36, emphasis added.] It is also noteworthy that the Holehan patent discusses moving a cursor (which is also referred to in the art as a "pointer") outside the context to scrolling (column 1, lines 20-27) and clearly indicates that the purpose of the invention disclosed in the Holehan patent is to avoid using a cursor when it is desired to cause a computer program to scroll (column 1, line 66 to column 2, line 19). Various computer-related dictionaries define "scroll bar" in essentially the same manner as the Holehan patent. For example, the WebopediaTM online dictionary defines a "scroll bar" as follows:

A bar that appears on the side or bottom of a window to control which part of a list or document is currently in the window 's frame. The scroll bar makes it easy to move to any part of a file.

[Exhibit 5, emphasis added.] Similarly, as shown in Exhibit 6, the ComputerUser.com High Tech Dictionary defines "scroll bar" as follows:

A bar at the bottom or side of a window which is used to scroll through a document. It has a little movable box inside it (called a thumb, or elevator). Clicking inside the scroll bar moves the screen in jumps. Sliding the little box along the bar makes it possible to move quickly move up, down, left, or right, to a chosen point in the document.

[Emphasis added.] Finally, it is also noteworthy that the aforementioned reference guide Omnibook 6000 notebook computer, which is attached hereto as Exhibit 1, distinguishes pointing with a pointer (page 26) and scrolling the contents of a window (page 27) by describing them under two separate headings.

In view of the forgoing, applicant respectfully submits that there is no reasonable interpretation of the claimed "a **touch pad ... adapted to move a pointer** on the display" that would read on the Holehan **scroll bar** sensors that are **adapted to move a scroll bar**. The combinability of the references notwithstanding, absent a

teaching of a touchpad, the Holehan patent simply cannot suggest adding a touchpad to the Brownlee keyboard. Applicant respectfully submits, therefore, that even when combined in manner proposed in the Office Action, the Brownlee and Holehan patents fail to teach or suggest the respective combinations of elements recited in independent claim 1, 9 and 16 and that the rejection of claims 1, 3-5, 7, 9, 11-13, 16-20 and 22-26 under 35 U.S.C. § 103 should be withdrawn.

Turning to claims 30 and 31, applicant respectfully submits that the Liao application fails to remedy the above-identified deficiencies in the Brownlee and Holehan patents. Claims 30 and 31 are, therefore, patentable for at least the same reasons as independent claims 1 and 9 and the rejection of claims 30 and 31 under 35 U.S.C. § 103 should also be withdrawn.

III. NEWLY PRESENTED CLAIMS 32-34

Newly presented claims 32-34 respectively depend from independent claims 1, 9 and 16 and, therefore, are patentable for at least the same reasons as claims 1, 9 and 16.

IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

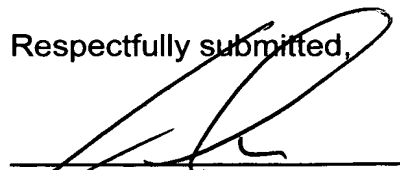
The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should

such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

3/28/05
Date

Henricks, Slavin & Holmes LLP
840 Apollo Street, Suite 200
El Segundo, CA 90245
(310) 563-1458
(310) 563-1460 (Facsimile)

Respectfully submitted,



Craig A. Slavin
Reg. No. 35,362
Attorney for Applicant

HP OmniBook 6000



Reference Guide



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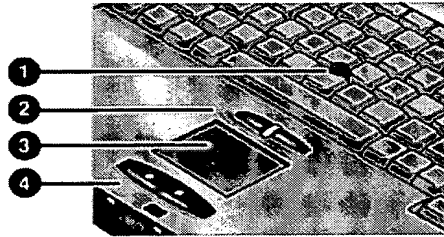
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**Hewlett-Packard Company
Mobile Computing Division
19310 Pruneridge Ave.
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To use the pointing devices

Your computer includes two built-in pointing devices: the pointing stick and touch pad.



1. Pointing stick (pressure-sensitive pointing device).
2. Click buttons and scroll button. The click buttons work like the left and right buttons on a standard mouse. The scroll button works with the pointing stick to scroll the contents of a window.
3. Touch pad (touch-sensitive pointing device).
4. Click buttons. These also work like the left and right buttons on a standard mouse.

Moving and selecting

1. Place your hands in a normal typing position.
2. **Pointing stick.** With your index finger, press the pointing stick in the direction you want the pointer to move.

Touch pad. Move a thumb or finger across the touch pad in the direction you want the pointer to move.

3. Use the left and right click buttons, which function like the left and right buttons on a mouse, to make your selection:
 - To open an application, move the pointer over the icon and double-click the left button.
 - To make menu selections, move the pointer to the menu item and click the left button.
 - To open the shortcut menu for an item, move the pointer over the item and click the right button.
 - To drag an item, move the pointer over the item. Then press *and hold* the left button while you move the pointer to the new location, and release the button.

Scrolling with the scroll button

- Hold down the scroll button and move the pointer using the pointing stick. The contents of the window scroll in the direction you move the pointer.

To configure the pointing devices

You can customize the operation of your computer's pointing devices (pointing stick, touch pad, and external PS/2 or serial mouse). You can change the left, right, and scroll button actions, double-click speed, pointer speed, and more. For details, click Help in the Mouse window.

- Double-click the touch pad icon in the task bar.
—or—
Click Start, Settings, Control Panel, then double-click Mouse.

To disable one pointing device

If you prefer to use only one of your computer's built-in pointing devices, you can disable the other. For example, if you notice that your hand inadvertently contacts the touch pad and moves the cursor while you're typing, consider disabling the touch pad.

1. Click Start, Settings, Control Panel, then double-click Mouse.
—or—
Double-click the touch pad icon in the taskbar.
2. Click the Touch tab, and select the device you want to disable from the pull-down menu.
3. Select Disable This Device near the bottom of the window.
4. Click OK.

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touchpad

A small, touch-sensitive pad used as a pointing device on some portable computers. By moving a finger or other object along the pad, you can move the pointer on the display screen. And you click by tapping the pad.

Last modified: Monday, May 18, 1998

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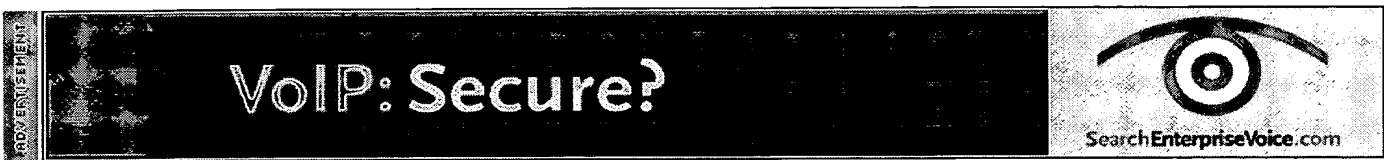
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touch pad

A touch pad is a device for pointing (controlling input positioning) on a computer display screen. It is an alternative to the [mouse](#). Originally incorporated in laptop computers, touch pads are also being made for use with desktop computers. A touch pad works by sensing the user's finger movement and downward pressure.

The first touch pad was invented by George E. Gerpheide in 1988. Apple Computer was the first to license and use the touch pad in its Powerbook laptops in 1994. The touch pad has since become the leading [cursor](#) controlling device in laptops. Many laptops use a [trackball](#). IBM ThinkPad laptops use a "pointing stick" (called a TrackPoint) that is set into the keyboard.

How the Touch Pad Works

The touch pad contains several layers of material. The top layer is the pad that you touch. Beneath it are layers (separated by very thin insulation) containing horizontal and vertical rows of *electrodes* that form a grid. Beneath these layers is a circuit board to which the electrode layers are connected. The layers with electrodes are charged with a constant alternating current (AC). As the finger approaches the electrode grid, the current is interrupted and the interruption is detected by the circuit board. The initial location where the finger touches the pad is registered so that subsequent finger movement will be related to that initial point. Some touch pads contain two special places where applied pressure corresponds to clicking a left or right mouse button. Other touch pads sense single or double taps of the finger at any point on the touch pad.

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pointer

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Grabber pointer



I-beam pointer

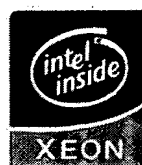


Selection pointer

(1) In graphical user interfaces, a pointer is a small arrow or other symbol on the display screen that moves as you move the mouse. You can select commands and options by positioning the tip of the arrow over the desired choice and clicking a mouse button. Many text processing programs use an *I-beam pointer*.

Pointers are often referred to as *mouse pointers*.

(2) A variable that contains the address of a location in memory. The location is the starting point of an allocated object, such as an object or value type, or the element of an array.



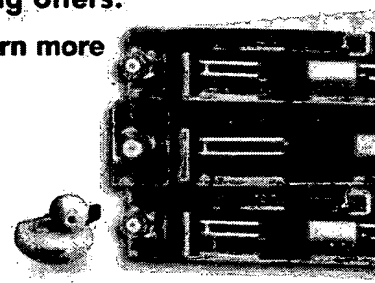
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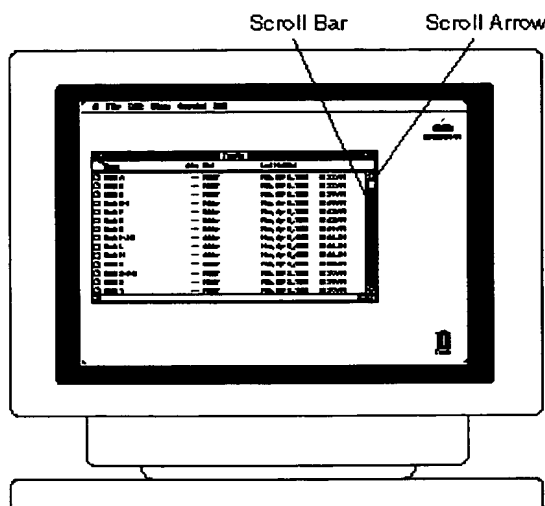
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scroll bar

Last modified: Wednesday, December 04, 2002



A bar that appears on the side or bottom of a window to control which part of a list or document is currently in the window's frame. The scroll bar makes it easy to move to any part of a file.

Typically, a scroll bar has arrows at either end, a gray or colored area in the middle, and a *scroll box* (or *elevator*) that moves from one end to the other to reflect your position in the document. Clicking on the arrows causes the document to scroll in the indicated direction. You can also quickly

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move to any part of a document by dragging the scroll box to the corresponding part of the scroll bar.

Many windowing systems support both horizontal and vertical scroll bars.

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Definition for: scroll bar

A bar at the bottom or side of a window which is used to scroll through a document. It has a little movable box inside it (called a thumb, or elevator). Clicking inside the scroll bar moves the screen in jumps. Sliding the little box along the bar makes it possible to move quickly move up, down, left, or right, to a chosen point in the document.

SEARCH

touch pad

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